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EXAMINER

SCHWARTZ, DARREN B

ART UNIT

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2435

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/522,819	<b>Applicant(s)</b> SHIBUI ET AL.	
	<b>Examiner</b> DARREN SCHWARTZ	<b>Art Unit</b> 2435	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

The Examiner has carefully considered arguments presented by applicant and applicant's representative.

1. In light of the amendments to claim 6, the 35 USC 112, second paragraph rejection is withdrawn.
2. In response to applicant's argument that "Berstis discloses a multi-user video hard disk recorder for recording and replaying television programs. This is totally remote from the technical field of machine tools and 'machine tool programs.'" Moreover, Berstis provides no teaching of how to solve the noted problems in the technical field of machine tools," a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.
3. Applicant argues "regarding claims 4 and 5, since these are dependent from claim 1 and Arnold does not teach what is missing in Berstis since it relates to an apparatus and method for the secure distribution of software, software updates and configuration and not 'machine tools' or 'machine tool programs'" (page 7 of REMARKS).

The Examiner disagrees. Berstis teaches a data processing unit (Fig 1A, 102 and Fig 2) and further teaches “Referring now to FIG. 2, a block diagram of the major components of data processing unit 102 in accordance with a preferred embodiment of the present invention is portrayed. As with conventional personal computers, data processing unit 102 includes...Memory 206 includes read only memory (ROM) 206a containing a basic input/output services (BIOS) routine and may include cache memory and/or video RAM” (col 4, lines 57-67).

The Examiner believes the data processing unit meets the “machine tools” & “machine tool programs” and its recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

4. Applicant argues the amended limitations to claim 1 which specifically recites the device inherent password is “inherent to the machine tool program unauthorized-use preventing device and set by a manufacturer of the machine tool program unauthorized-use preventing device” and believes the essential features of the amended “processing section” are silent in Berstis.

5. The Examiner disagrees. Berstis clearly states the following:

“Referring back to FIG. 3, the master user enters the new user's name and selects a password for the new user (step 316). Rather than setting a password, a variety of security controls may be used for each user in the

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system. As discussed above, these security controls may include a smart card for each user, or some other type of security mechanism” (col 7, lines 43-49).

One of ordinary skill in the art would appreciate that at the time smart cards are manufactured, they are designed to be compatible with their respective set-top-boxes/readers and may contain sensitive information. In this case, Berstis teaches embedding the password in a hardware device, e.g. a smart card. It is well known that smart cards can be inserted into a smart card reader, in this case, data processing unit 102.

However, in the alternative, the Examiner has updated the search of the prior art and presents explicit teachings and motivation in the prior art for the amended limitations. The Examiner notes that the introduction of new prior art, Panjwani et al (U.S. Pat Pub 2002/0018569 A1), as been necessitated by applicant's amendment to the claims.

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3 and 6-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Berstis (U.S. Pat 6564005 B1), hereinafter referred to as Berstis.

Re claim 1: Berstis teaches a machine tool program unauthorized-use preventing device comprising:

a storage section [Fig 2, elt 220] for storing various optional operation machine tool programs in a machine tool (col 5, lines 53-55);

a display section [Fig 1A, elt 105] (col 3, lines 31-32) for displaying a first program-selection image [Fig 3, elt 310; Fig 4: "Master User Menu"] and a second program-selection image [Fig 7, elt 410; Fig 8: "User Menu"] (col 7, lines 23-30; col 8, lines 9-14), separately from each other (Fig 4, Fig 8; only one of the "Master User Menu" or "User Menu" can be displayed at any one time; Fig 4 and Fig 8 are clearly distinct), a desired one of said operation programs being allowed to be selected on respective first (Fig 4: "Master User Menu;" col 7, lines 25-30) and second program-selection images (Fig 8: "User Menu;" col 8, lines 11-14); and

a processing section [Fig 1A, elt 102] for processing to read out (col 3, lines 31-32), when a device inherent password [master user password] inherent to the machine tool program unauthorized-use preventing device and set by a manufacturer of the machine tool program unauthorized-use preventing device (col 7, lines 43-49) is input (Fig 3, elts 302 & 304; col 7, lines 14-16), said desired operation program selected on said first program-selection image from said storage section (col 5, lines 53-55; col 7, lines 23-35

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and lines 43-46) and bring said desired operation program into a usable state (col 31-35: the “New user Menu” is shown), while to read out, when a machine-tool inherent password [user password] different from said device inherent password, inherent to the machine tool, into which the machine tool program unauthorized-use preventing device is installed, and set by a manufacturer of the machine tool (col 7, lines 43-49), is input (Fig 7, elts 402 & 404; col 8, lines 5-8), said desired operation program selected on said second program-selection image from said storage section (col 5, lines 53-55; col 8, lines 21-22) and bring said desired operation program into a usable state (col 8, lines 15-21).

Re claim 2: Berstis further teaches said storage section includes a program storage area for storing said various optional operation programs and an image storage area for storing said first and second program-selection images (col 5, line 53-55; col 6, lines 28-35 and lines 38-40); and

wherein said processing section processes to read out (col 3, lines 31-32), when said device inherent password [master user password] is input (Fig 3, elts 302 & 304; col 7, lines 14-16), said first program-selection image from said image storage area (col 5, lines 53-55; col 7, lines 23-35 and lines 43-46) and make said display section display said first program-selection image (Fig 3, elt 310; col 7, lines 23-30), while to read out (col 3, lines 31-32), when said machine-tool inherent password [user password] is input (Fig 7, elts 402 & 404; col 8, lines 5-8), said second program-selection image from said image storage area and make said display section display said second program-selection image (Fig 7, elt 410; col 8, lines 9-13).

Re claim 3: Berstis further teaches wherein said processing section processes to bring, when selection of said operation program is performed respectively on said first and second program-selection images, only said desired operation program selected on said second program-selection image into a usable state (col 6, lines 54-65).

Re claim 6: Berstis further teaches said first and second program-selection images have an image configuration identical to each other (Fig 4 and Fig 7 have a menu title name and a plurality of options for the user from which he/she may choose).

Re claim 7: Berstis further teaches configured to be incorporated into a numerical control device (col 5, lines 2-5; col 11, lines 17-20).

Re claim 8: Berstis further teaches each of said first and second program-selection images displays a list of program names of said various optional machine tool operation programs (Figures 4, 5, 6 and 8 all show various menus).

Re claim 9: Berstis further teaches said second program-selection image is prepared by the manufacturer of the machine tools (col 5, lines 53-55).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berstis (U.S. Pat 6564005 B1), hereinafter referred to as Berstis, in view of Panjwani (U.S. Pat Pub 2002/0018569 A1), hereinafter referred to as Panjwani.



Re claim 1: Berstis teaches a machine tool program unauthorized-use preventing device (see above). Panjwani teaches: a device inherent password inherent to the machine tool program unauthorized-use preventing device and set by a manufacturer of the machine tool program unauthorized-use preventing device and said device inherent password, inherent to the machine tool, into which the machine tool program unauthorized-use preventing device is installed, and set by a manufacturer of the machine tool (¶46).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the teachings of Berstis with the teachings of Panjwani, for the purpose of preventing modification and protecting data between two parties.

8. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berstis (U.S. Pat 6564005 B1), hereinafter referred to as Berstis, in view of Arnold (U.S. Pat 5956408 A), hereinafter referred to as Arnold.

Re claim 4: Berstis teaches an interface section connectable to an external storage unit storing specific data (col 2, lines 31-35); wherein said processing section processes, through said interface section, said desired operation program selected on said second program-selection image into a usable state (col 10, lines 56-64).

However, Arnold teaches: to identify a validity (Fig 3, elt 160: digital signature) of said specific data (Fig 3, elt 100; col 6, lines 66-67) stored in said external storage unit

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(col 6, lines 62-65) and bring (Fig 3, elts 140 & 180), only when said specific data are judged to be valid (Fig 3, elts 160, 170 & 180; col 7, lines 31-36).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have been modified Berstis to validate external data usable by said security device for the purpose of using authenticate data provided on an external medium.

Re claim 5: Berstis teaches an interface section connectable to an external computer in turn connectable to an external storage unit storing specific data (col 2, lines 31-35); said desired operation program selected on said second program-selection image into a usable state (col 10, lines 56-64).

However, Arnold teaches: wherein said processing section processes to bring, only when said external computer judges said specific data stored in said external storage unit (col 6, lines 62-65) to be valid (Fig 3, elts 160, 170 & 180; col 7, lines 31-36).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have been modified Berstis to validate external data usable by said security device for the purpose of using authenticate data provided on an external medium.

### ***Conclusion***

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although

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the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the text of the passage taught by the prior art or disclosed by the examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DARREN SCHWARTZ whose telephone number is (571)270-3850. The examiner can normally be reached on 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571)272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. S./

Examiner, Art Unit 2435

/Kimyen Vu/

Supervisory Patent Examiner, Art Unit 2435